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EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,289

Applicant(s)

NORMAN ET AL. *sf*

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 and 28-32 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-30 and 32 is/are allowed.
- 6) ☒ Claim(s) 2-4 and 13-24 is/are rejected.
- 7) ☒ Claim(s) 5-12, 25-26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 31, 2-3, 13-15 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Scoville (US 2701027).

Scoville discloses an underground retention apparatus comprising in combination means (12,13 and the top half of the vertical part of members (11,18,21)) for providing

Art Unit: 3673

perimeter structural support; means (this is considered as the bottom half of the vertical part of members (11,18,21) and the bottom of member 11) for holding a quantity of run off water secured to the perimeter support means; means ((16) the opening in member 15, (the opening (22) where water flows into the apparatus)) for draining run off water onto the means for holding a quantity of run off water; means for draining the run off water from the means for holding a quantity of run off water (the opening (22) where water flows away from the apparatus, see col. 2 line 16+); and means (the solid portion of member (15)) for providing a roof for covering the holding means and for providing structural support for appropriate usage of the roof means and disposed on the perimeter support means.

(Re claims 2,18), the perimeter support means (this is considered as the top half of the vertical part of members (11,18,21) and 12,13) comprises a generally vertically retaining wall (see Figs. 1,2).

(Re claim 3), the means for draining run off from the holding means includes a dry well (see col. 2 line 34).

(Re claim 13), the holding means includes an upper side wall portion (this is considered as a top portion of the bottom half of the vertical part of members (11,18,21)), a lower side wall portion (this is considered as a bottom portion of the bottom half of the vertical part of members (11,18,21)), and a bottom portion (this is considered as the bottom of member 11).

(Re claims 14,15), since applicant does not specify with respect to what reference point the term shallow angle and steep angle are measured to; it appears

Art Unit: 3673

based on Figures 3 and 4, that Scoville discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle.

(Re claim 19), the holding means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

(Re claim 22), the perimeter support means includes a stepped retaining wall (this is considered as part of members (12,13) depicted in Figure 2 as well as the top half of the vertical part of members (11,18,21)).

(Re claim 23), the perimeter support means includes a plurality of relatively short stepped retaining walls (see Fig. 4, wherein there are a plurality of retaining walls shown).

(Re claim 24), the holding means is secured to the stepped retaining walls.

3. Claims 31, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitfield, Jr. (US 6419421).

Whitfield, Jr. discloses an underground retention apparatus ((11), see Fig. 7) comprising in combination means (2) for providing perimeter structural support; means (3) for holding a quantity of run off water secured to the perimeter support means; means (this is considered as the hole (shown in member 3) where water enters the retention apparatus, or the grate openings shown in Fig. 7) for draining run off water

Art Unit: 3673

onto the means for holding runoff water; means (this is considered as the hole (shown in member 3) where water leaves the retention apparatus) for draining the run off water from the means for holding water runoff; and roof means (5) disposed on the perimeter support means for covering the holding means and for providing structural support for appropriate usage of the roof means.

(Re claim 13), the liner means includes an upper side wall portion (this is considered as a top portion of side plate (3)), a lower side wall portion (this is considered as a middle portion of side plate (3)), and a bottom portion (this is considered as the bottom portion of side plate (3)).

Re claims 14,15), since applicant does not specify with respect to what reference point the term shallow angle and steep angle are measured to; it appears that Whitfield Jr. discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle.

(Re claim 16), the liner is made of plastic (see abstract).

4. Claims 31, 2, 13-15, 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan et al. (US 3950252).

Jordan et al. discloses an underground retention apparatus (20, see Fig. 7) comprising in combination means (see Fig. 7, (100)) for providing perimeter structural support; means (97,22, 24,27-30) for holding a quantity of runoff water secured to the perimeter support means; means (63 or holes in member (101) shown in Figure 7) for draining run off waste water onto the holding means; means for draining the filtered

Art Unit: 3673

water from the holding means (83); and roof means (member 101 or the solid portion or member 101 depicted in Figure 7) disposed on the perimeter support means for covering the holding means and for providing structural support for appropriate usage of the roof means.

(Re claims 2, 18), the perimeter support means comprises a retaining wall.

(Re claims 13-15), Jordan et al. discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle (see Figs. 2 and 7).

(Re claim 17), the liner is made of cementitious material (see col. 2 line 1)

(Re claim 19), the liner means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

(Re claim 22), the perimeter support means includes a stepped retaining wall (100, see Fig. 7).

(Re claim 23), the perimeter structural support means is considered as members (100 and 97) and the holding means is considered as (22,24,27-30)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville '027.

Scoville discloses the invention substantially as claimed. However, Scoville is silent about the holding means being made out of either plastic or cementitious material. The examiner takes official notice that it is well known to make liner/reservoir/drainage means out of plastic or cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Scoville by making his liner out of plastic or cementitious since such material are known to be used to make liners/reservoirs/drainage means in order to have liner/reservoir/drainage means that would not be subjected to rust. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville '027 in view of Zimmerman (US 4298294)

Scoville '027 discloses the invention substantially as claimed. However, Scoville lacks having a pump to drain the water run off from the holding means. Zimmerman teaches having a pump to drain water (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to modify Scoville to include a pump as taught by Zimmerman in order to facilitate the transport of the water run off to a desired location.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield, Jr..

Art Unit: 3673

Whitfield, Jr. discloses the invention substantially as claimed. However, Whitfield, Jr. is silent about the liner being made out of cementitious material. The examiner takes official notice that it is well known to make liner/reservoir out of cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Whitfield, Jr. by making his liner out of cement since such material is known to be used to make liners in order to have liner/reservoir that would not be subject to rust. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield, Jr. (US 6419421) in view of Zimmerman (US 4298294).

Whitfield, Jr. discloses the invention substantially as claimed. However, Whitfield, Jr. lacks having a pump to drain the water run off from the holding means. Zimmerman teaches having a pump to drain water (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to modify Whitfield Jr. to include a pump as taught by Zimmerman in order to facilitate the transport of the water run off to a desired location.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al. in view of Zimmerman (US 4298294).

Jordan et al. discloses the invention substantially as claimed. However, Jordan et al. lacks having a pump to drain the water run off from the holding means.

Art Unit: 3673

Zimmerman teaches having a pump to drain water (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to modify Jordan et al. to include a pump as taught by Zimmerman in order to facilitate the transport of the water run off to a desired location.

Response to Arguments

11. Applicant's arguments filed 2/24/03 have been fully considered but they are not persuasive. Applicant argues that Scoville teaches a floor drain and not an underground water retention apparatus. Insofar applicant's apparatus can retain water then so can Scoville, there is no structural limitation in the rejected claims precluding Scoville from retaining water. Applicant argues that comparing Scoville to the invention is like comparing a bicycle to a truck. The examiner does not agree. It is unclear how such analogy sets forth what is structural different in the rejected claims from that being disclosed by Scoville. Applicant argues that Scoville does not have separate support means and holding means. It should be noted that such argument is far more limiting than the claimed subject matter. Where in the rejected claims do it say that the support means is separate from the holding means. Applicant argues that Scoville does not have separate roof means and draining means. It should be noted that such argument is far more limiting than the claimed subject matter. Where in the rejected claims do it say that the roof means is separate from the draining means. Even so, the solid portion of member (15) can be considered the roof means and the holes in member 15 namely 16 can be considered the draining means. In the event applicant does not agree, then the examiner would consider member (22) where water flows into the retention

Art Unit: 3673

apparatus as the draining means. Applicant argues that one cannot compare a tiny floor drain to a large water retention apparatus. Once again nothing in the rejected claims precludes Scoville from anticipating them.

12. Applicant's arguments filed 6/24/03 have been fully considered but they are not persuasive. Applicant argues that Whitfield teaches a very small plastic basin with a 3" diameter input hole and using that as a scale the apparatus is probably no larger than about nine inches by twelve inches. Moreover, the apparatus is clearly defined as plastic. Such a statement might be true. However, the examiner is yet to see what is recited in claim 31 that prevents Whitfield from reading on it. For example does claim 31 preclude the underground water retention apparatus from **not being plastic**? The answer is no; therefore, Whitfield anticipates claim 31. Does claim 31 preclude the underground water retention apparatus from **not being 9" by 12"**? The answer is no; therefore, claim 31 is anticipated by Whitfield. Applicant argues that Whitfield does not define a structure that "resembles" his invention. While such a statement maybe true, there is nothing in the rejected claims that structurally define over the apparatus disclosed by Whitfield. Applicant argues that the corner posts (2) disclosed by Whitfield cannot be considered as "perimeter support means". The examiner disagrees since top member (5) sits on posts (2) along its perimeter, therefore post (2) is considered as perimeter support means. Applicant argues that the walls (3) and the floor (6) of Whitfield cannot be considered a liner means. The examiner disagrees in as much applicant's walls and floor are considered liner means (see Fig. 9 of applicant's

Art Unit: 3673

drawings) then the walls (3) and floor (6) of Whitfield are considered liner means.

Applicant argues that the structure disclosed by Whitfield amounts to a small plastic toy drain which is different from his invention. Once again the examiner would like to point out there is **nothing** in the rejected claims that structurally defines applicant's invention over the Whitfield reference.

13. Applicant argues that claim 31 of his invention defines over Jordan et al. since Jordan et al. does not "resemble" it. Once again while such a statement maybe true, there is nothing in the rejected claims that structurally define over the apparatus disclosed by Jordan et al.. Applicant argues that members (97, 22,24,27-30) of Jordan et al. cannot be considered as "holding means" secured to perimeter support means (100, see Fig. 7). The examiner does not quite understand such statement since members (97,22,24,27-30) lines the cavity in the ground and is secured to the perimeter support means (100, see Fig. 7). Applicant argues that Jordan et al. teaches a home sewage system not a water retention system as his invention. The examiner would like to point out to applicant that home sewage does contain water and at some point it is retained within the structure defined by Jordan et al.

14. Applicant's arguments filed 12/04/03 have been fully considered but they are not persuasive. With respect to Whitfield Jr. applicant argues that the examiner cannot consider four spaced apart elements as perimeter support means. To refute applicant's argument the examiner would like to direct applicant to Figs. 7-9 of his specification where spaced apart caissons (112,122) and (118,128) along the perimeter (where members 150,154 are pointing) are considered to be perimeter support means and

Art Unit: 3673

insofar such an interpretation can be given, then the examiner above interpretation of Whitfield Jr's. support means is correct. Applicant continually argues that the apparatus shown in Whitfield does not resemble his invention. There is no structural limitation recited in the rejected claims that precludes Whitfield from anticipating them.

15. With respect to Jordan, applicant once again argues that is does not resemble his apparatus. In response to such argument, applicant is directed to discussion above that addresses this same issue. Applicant's argument that states there is no separate liner means and support means is not concurred with. Please see Figure 7, support means (100) and liner means (97,22,24,27-30). In response to applicant's argument that Jordan et al. does not teach a water retention apparatus for property being developed, it should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With regards to applicant's confusion as to how claims 13-15 were rejected, the examiner would like to direct applicant to Figures 7 and 1 where holding means is considered as member (97,22,24,27-30).

With regards to applicant's confusion as to how claim 22 was rejected, the examiner would like to direct applicant to Figure 7 where support means (100) is shown.

16. Applicant's arguments filed 8/14/04 have been fully considered but they are not persuasive. Applicant argues that the examiner cannot consider four spaced apart elements as perimeter support means. To refute applicant's argument the examiner would like to direct applicant to Figs. 7-9 of his specification where spaced apart caissons (112,122) and (118,128) along the perimeter (where members 150,154 are pointing) are considered to be perimeter support means and insofar such an interpretation can be given, then the examiner above interpretation of Whitfield Jr's. support means is correct. Applicant argues that the walls (3) and the floor (6) of Whitfield cannot be considered a liner means. The examiner disagrees in as much applicant's walls and floor are considered liner means (see Fig. 9 of applicant's drawings) then the walls (3) and floor (6) of Whitfield are considered liner means.

17. With regards to the limitation of "means for draining runoff water onto the liner", this is considered as the hole (shown in member 3) where water enters the retention apparatus, or the grate openings shown in Fig. 7) for draining run off water onto the means for holding runoff water; with regards to "means for draining runoff water from the liner" this is considered as the hole (shown in member 3) where water leaves the retention apparatus) for draining the run off water from the means for holding water runoff. Applicant argues that "a parking lot" is appropriate usage for the roof means. It should be noted that such limitation is far more limiting than the claimed subject matter.

18. With respect to claim 13, applicant argues that the holding means does not have three separate side walls. The claims do not call for separate side walls. In response to applicant's argument that there is no suggestion to combine the references, the

Art Unit: 3673

examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to one skilled in the art to add a pump to the Whitfield Jr. in order to facilitate the removal of the drainage water.

Allowable Subject Matter

19. Claims 28-30 and 32 are allowed.
20. Claims 5-12 and 25, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
21. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

Art Unit: 3673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



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